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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/075,519	02/13/2002	Flora P. Goldthwaite	MSFT-0738/183225.1	8922

41505 7590 04/07/2008
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EXAMINER

WOO, ISAAC M

ART UNIT	PAPER NUMBER
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2166

MAIL DATE	DELIVERY MODE
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04/07/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/075,519	Applicant(s) GOLDTHWAITE ET AL.	
	Examiner ISAAC M. WOO	Art Unit 2166	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/13/2002</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is response to the application filed, on February 13, 2002. Claims 1-32 are presented for examination.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-11 and 22-32 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As set forth in MPEP 2106 (II) (A):

A. Identify and Understand Any Practical Application Asserted for the Invention

The claimed invention as a whole must accomplish a practical application. That is, it must produce a "useful, concrete and tangible result." State Street, 149 F.3d at 1373, 47 USPQ2d at 1601-02. The purpose of this requirement is to limit patent protection to inventions that possess a certain level of "real world" value, as opposed to subject matter that represents nothing more than an idea or concept, or is simply a starting point for future

investigation or research (Brenner v. Manson, 383 U.S. 519, 528-36, 148 USPQ 689, 693-96); In re Ziegler, 992, F.2d 1197, 1200-03, 26 USPQ2d 1600,1603-06 (Fed. Cir. 1993)). Accordingly, a complete disclosure should contain some indication of the practical application for the claimed invention, i.e., why the applicant believes the claimed invention is useful.

Apart from the utility requirement of 35 U.S.C. 101, usefulness under the patent eligibility standard requires significant functionality to be present to satisfy the useful result aspect of the practical application requirement. See Arrhythmia, 958 F.2d at 1057, 22 USPQ2d at 1036. Merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make the invention eligible for patenting. For example, a claim directed to a word processing file stored on a disk may satisfy the utility requirement of 35 U.S.C. 101 since the information stored may have some "real world" value. However, the mere fact that the claim may satisfy the utility requirement of 35 U.S.C. 101 does not mean that a useful result is achieved under the practical application requirement. The claimed invention as a whole must produce a "useful, concrete and tangible" result to have a practical application.

Claims 1-11 are non-statutory. Because claim 1 ends with "set of instructions for correlating selected multimedia files", which does provide any practical or real world application. Thus, the claims 1-11 are not a statutory and should be rejected under 35 U.S. C. § 101 as not being tangible.

Claims 1-11 are non-statutory. Because claims 1-11 do provide any claim class statutory type (such as, method, system, apparatus, etc.,). Appropriate correction is required.

Claims 22-32 are non-statutory. Because computer readable-instructions are not executed by computer-readable medium.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Yuhn (US Patent No. 6,052,440).

With respect to claims 1, 12 and 22, Yuhn teaches a first data store comprising multimedia files (col. 2, lines 60-67 to col. 2, lines 1-27, col. 5, lines 35-67 to col. 6, lines 1-50); a second data store comprising schedule data (col. 2, lines 60-67 to col. 2, lines 1-27, col. 5, lines 35-67 to col. 6, lines 1-50, col. 3, lines 43-67 to col. 4, lines 1-65) ; and, a set of instructions for correlating selected multimedia files from the first data store with selected schedule data from the second data store wherein the instructions provide

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information indicative of the correlated file by way of a network connection (col.1, lines 6-47, col. 2, lines 60-67 to col. 2, lines 1-27, col. 5, lines 35-67 to col. 6, lines 1-50, col. 3, lines 43-67 to col. 4, lines 1-65)

With respect to claims 2 and 3, Yuhn teaches at least one of an audio file and a video file (col. 1, lines 64-67 to col. 2, lines 1-27).

With respect to claim 4, Yuhn teaches the correlation is based on time information associated with the multimedia files and time information associated with the schedule data (col. 1, lines 64-67 to col. 2, lines 1-27).

With respect to claim 5, Yuhn teaches the correlation is based upon a second correlation factor (col. 1, lines 64-67 to col. 2, lines 1-27).

With respect to claim 6, Yuhn teaches the second correlation factor is location (col. 1, lines 64-67 to col. 2, lines 1-27).

With respect to claim 7, Yuhn teaches the location is a function of latitude and longitude (col. 1, lines 64-67 to col. 2, lines 1-27).

With respect to claim 8, Yuhn teaches the multimedia files are generated by a first application and the schedule data is generated by a second application (col. 1, lines 64-67 to col. 2, lines 1-27).

With respect to claim 9, Yuhn teaches an Internet connection (col. 1, lines 64-67 to col. 2, lines 1-27).

With respect to claim 10, Yuhn teaches the correlation is based upon a probability that the selected multimedia files are related to an event indicated by the selected schedule data (col. 1, lines 64-67 to col. 2, lines 1-27).

With respect to claim 11, Yuhn teaches the correlation is based upon a clustering (col. 1, lines 64-67 to col. 2, lines 1-27).

With respect to claims 13-15, Yuhn teaches image data, audio data and text files(col. 1, lines 64-67 to col. 2, lines 1-27).

With respect to claim 16, Yuhn teaches calendar data (col. 1, lines 64-67 to col. 2, lines 1-27).

With respect to claim 17, Yuhn teaches determining a probability that the function of time indicates that the media files have an association with the selected records (col. 1, lines 64-67 to col. 2, lines 1-27).

With respect to claim 18, Yuhn teaches correlating the select media files with the selected records in time and space (col. 1, lines 64-67 to col. 2, lines 1-27).

With respect to claim 19, Yuhn teaches the correlation in space is a function of a geographic location data associated with the selected media files and geographic location data associated with the selected records (col.1, lines 6-47, col. 2, lines 60-67 to col. 2, lines 1-27, col. 5, lines 35-67 to col. 6, lines 1-50, col. 3, lines 43-67 to col. 4, lines 1-65).

With respect to claim 20, Yuhn teaches the method is provided as a network service over a network connection (col.1, lines 6-47, col. 2, lines 60-67 to col. 2, lines 1-27, col. 5, lines 35-67 to col. 6, lines 1-50, col. 3, lines 43-67 to col. 4, lines 1-65).

With respect to claim 21, Yuhn teaches computer-readable medium bearing computer-readable instructions (col.1, lines 6-47, col. 2, lines 60-67 to col. 2, lines 1-27, col. 5, lines 35-67 to col. 6, lines 1-50, col. 3, lines 43-67 to col. 4, lines 1-65).

With respect to claim 23, Yuhn teaches reading data from one of the first data store and the second data store over a network (col.1, lines 6-47, col. 2, lines 60-67 to col. 2, lines 1-27, col. 5, lines 35-67 to col. 6, lines 1-50, col. 3, lines 43-67 to col. 4, lines 1-65).

With respect to claims 24-26, Yuhn teaches image data, audio data and text files (col. 1, lines 64-67 to col. 2, lines 1-27).

With respect to claim 27, Yuhn teaches calendar data (col. 1, lines 64-67 to col. 2, lines 1-27).

With respect to claim 28, Yuhn teaches determining a probability that the function of time indicates that the media files have an association with the selected records (col. 1, lines 64-67 to col. 2, lines 1-27).

With respect to claim 29, Yuhn teaches correlating the select media files with the selected records in time and space (col. 1, lines 64-67 to col. 2, lines 1-27).

With respect to claim 30, Yuhn teaches the correlation in space is a function of a geographic location data associated with the selected media files and geographic location data associated with the selected records (col.1, lines 6-47, col. 2, lines 60-67 to col. 2, lines 1-27, col. 5, lines 35-67 to col. 6, lines 1-50, col. 3, lines 43-67 to col. 4, lines 1-65).

With respect to claim 31, Yuhn teaches the method is provided as a network service over a network connection (col.1, lines 6-47, col. 2, lines 60-67 to col. 2, lines 1-27, col. 5, lines 35-67 to col. 6, lines 1-50, col. 3, lines 43-67 to col. 4, lines 1-65).

With respect to claim 32, Yuhn teaches data from a first application and the second data store comprises data from a second data store (col.1, lines 6-47, col. 2,

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lines 60-67 to col. 2, lines 1-27, col. 5, lines 35-67 to col. 6, lines 1-50, col. 3, lines 43-67 to col. 4, lines 1-65).

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ISAAC M. WOO whose telephone number is (571)272-4043. The examiner can normally be reached on 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain T. Alam can be reached on (571) 272-3978. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Isaac M. Woo/
Primary Examiner, Art Unit 2166